

Application No.: 10/665,222
Response dated April 6, 2006
Reply to Office Action mailed January 17, 2006

REMARKS/ARGUMENTS

The Office Action of January 17, 2006 has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested.

Claims 1-5 and 7-42 are pending. Claims 1-4, 8, 10-14, 16-19, 21-22, 24-25 27-29 and 33 were rejected under 35 U.S.C. 102(b) as being anticipated by Stahl (5,422,173). Claims 7, 15, 20, 30-32 and 38-41 were rejected under 35 U.S.C. 103(a) as being unpatentable over Stahl in view of Mahn (4,971,644). Claims 9, 23, 26, 34-37 and 42 were rejected under 35 U.S.C. 103(a) as being unpatentable over Stahl in view of either Conrad (4,662,878) or Castro (5,906,006). Claim 5 was rejected under 35 U.S.C. 112, second paragraph, as failing to comply with the written description requirement.

By this response, claims 1, 16, 24 and 34 have been amended. Claim 5 has been canceled.

Rejection Under 35 U.S.C. § 102(b)

Claims 1-4, 8, 10-14, 16-19, 21-22, 24-25, 27-29 and 33 were rejected under 35 U.S.C. 102(b) as being anticipated by Stahl (5,422,173).

Stahl is directed to a method of producing a multi-colored emblem with an embroidered appearance, the emblem being heat sealable onto difficult-to-adhere fabrics. *See Abtract*. The method includes providing a first woven material blank, laminating a thermoplastic material onto the blank to form an assembly, sewing the periphery of the blank to produce an embroidered appearance, providing a second woven material blank of a different color, laminating a thermoplastic material onto the second blank to form an assembly, sewing the periphery of the second blank to produce an embroidered appearance, heat sealing the first and second blanks together, and providing an adhesive layer to the exposed side of the second blank and across the entire exposed side of the second cut blank. *See Col. 1, line 60 to Col. 2, line 12; Fig. 2*. The

Application No.: 10/665,222
Response dated April 6, 2006
Reply to Office Action mailed January 17, 2006

emblem with an embroidered appearance can then be applied to a fabric and heat sealed to that fabric. Col. 2, line 13-25.

In contrast, the method of joining a plurality of textile elements, as recited in amended independent claim 1, recites, among other steps, the step of "forming a first bond between the third textile element and the adhesive element to define a bonded area and an unbonded area on a first side of the third textile element, the first bond being located on the first side of the third textile element and in a spaced relationship with at least some of outer edges of the third textile element." Similarly, the method of joining a plurality of textile elements, as recited in amended independent claim 16, recites, among other steps, the step of "forming a first bond between the second textile element and the adhesive element through the application of heat and pressure to define a bonded area and an unbonded area on a first side of the second textile element, the first bond being located on the first side of the second textile element and in a spaced relationship with at least some of outer edges of the second textile element." This step of forming a bond that includes a bonded area and an unbonded area on a first side of the textile element where the bond is located in a spaced relationship with some of the outer edges of the same textile element is not shown or taught by Stahl. Indeed, Stahl teaches away from the methods of claims 1 and 16 in that Stahl teaches applying an adhesive layer 24 and 28 across the entirety of the blanks 22 and 26, respectively, and therefore does not teach a bonded and unbonded area on a side of a textile element where the bond is spaced from the edges of the same textile element. See Col 3, lines 15-22; Col. 4, lines 4-13; Figs. 2, 8, 9 and 11. It is respectfully submitted this clarification overcomes the Examiner's statement on page 5 of the Office Action concerning the spacing of blanks 22 and 26 and their purported teaching of the instant claims. Specifically, the Examiner indicates that "the bond between element 22 and element 26 is spaced from the entire outer edge of the element 26. In contrast, the recited bond of the instant claims 1 and 16 require the bond to be on a side of the textile element and spaced from the edges of the same textile element. This is

Application No.: 10/665,222
Response dated April 6, 2006
Reply to Office Action mailed January 17, 2006

not shown or taught by Stahl and therefore Stahl does not anticipate independent claims 1 and 16.

Similarly, independent claim 24 is not anticipated by Stahl. Claim 24 recites, among other features, an article including "a second textile element defining an outer perimeter, the second textile element extending over the first textile element and bonded only at the outer perimeter to the first textile element." Stahl simply does not teach the technique of seam bonding discussed in the specification and recited by claim 24. Rather, as discussed above, Stahl teaches applying an adhesive layer across the entirety of the blanks to join the blanks together in a stacked manner, that is, one blank on top of the other. Additionally, Stahl does not teach the recited article of claim 24 including the three textiles bonded in the manner described in the claim. Rather, Stahl teaches two arguable textile elements -- blank 22 joined to blank 26. The Examiner identifies element 30 as a third textile element; however, element 30 is a paper carrier for the adhesive element 28, and not the recited textile element. For these reasons, Stahl does not anticipate claim 24.

Rejection Under 35 U.S.C. § 103(a)

Claims 7, 15, 20, 30-32 and 38-41 were rejected under 35 U.S.C. 103(a) as being unpatentable over Stahl in view of Mahn (4,971,644). Claims 9, 23, 26, 34-37 and 42 were rejected under 35 U.S.C. 103(a) as being unpatentable over Stahl in view of either Conrad (4,662,878) or Castro (5,906,006).

For the same reasons expressed above, Mahn, Conrad or Castro does not render obvious the pending application because these references do not obviate the noted deficiencies in Stahl. Mahn discloses a method of applying a heat activated transfer to a foraminous substrate. *See* Col. 2, line 45. The heat activated transfer includes an upper bearing layer and a lower heat activated adhesive layer. This is applied to a cloth. Col. 2, line 46-49. Mahn does not teach or suggest forming a bond that has a bonded area and an unbonded area on a side of a textile element, nor does Mahn teach the technique of forming a bond only at an outer perimeter on the same textile element. Consequently, Mahn does not render obvious the pending claims

Application No.: 10/665,222
Response dated April 6, 2006
Reply to Office Action mailed January 17, 2006

Moreover, Conrad or Castro does not render obvious the pending application because Conrad teaches the use of an "interposed layer of thermoplastic or glue" which extends across the entirety of a patch that is to be attached to a garment. See Col. 1, lines 23-26. Likewise, Castro teaches attaching a logo or emblem across headwear by adhesives, presumably applied across the entirety of the logo.

For the foregoing reasons, the Applicant respectfully submits that claims 7, 9, 15, 20, 23, 26, 30-32, 34-37 and 42 are allowable over Stahl in view of Mahn, Conrad or Castro.

Rejection Under 35 U.S.C. § 112

Claim 5 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite. In response, claim 5 has been canceled.

CONCLUSION

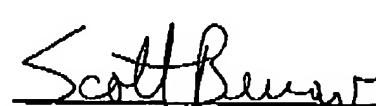
It is believed that all claims are in allowable condition. The Commissioner is hereby authorized to charge any fee due or credit any overpayment of fee to Deposit Account No. 19-0733.

All rejections and objections having been addressed, the Applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same.

Respectfully submitted,
BANNER & WITCOFF, LTD.

Dated: April 6, 2006

By:



Scott A. Burow
Registration No. 42,373

Banner & Witcoff, LTD.
Ten South Wacker Drive
Chicago, Illinois 60606
Tel: (312) 463-5000
Fax: (312) 463-5001